Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte THOMAS I. BURENGA and ROSS D. KOBERLEIN

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Appeal No. 2000-2022
Application No. 08/888,663

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ON BRIEF

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Before CALVERT, FRANKFORT, and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2 to 4 and 6 to 10, all the claims remaining in the application.

The claims on appeal are drawn to a post driver, and are reproduced in the appendix of appellants' brief.

The references applied in the final rejection are:

Gustafson	2,894,723	Jul. 14, 1959
Shaver	2,940,267	Jun. 14, 1960
Burenga et al. (Burenga)	5,282,511	Feb. 1, 1994
Horn et al. (Horn)	5,437,341	Aug. 1, 1995

The appealed claims stand finally rejected under 35 U.S.C. § 103(a) on the following grounds:

(1) Claims 2, 6, 9 and 10, unpatentable over Burenga in view of Horn and Shaver;

(2) Claims 3, 4, 7 and 8, unpatentable over Burenga in view of Horn, Shaver and Gustafson;

(3) Claim 10, unpatentable over Horn in view of Shaver.[1]

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 2 to 4 and 6 to 10 are rejected as being unpatentable for lack of compliance with the second paragraph of 35 U.S.C. § 112.

As an element of the claimed combination, independent claims 6 and 9 each recite

[1] The examiner inadvertently omits Shaver from the statement of this rejection on page 5 of the answer.

> means for adjusting the lateral and forward positioning of said carriage and post driver approximately generally parallel to the ground to properly position the post driver during its usage

and independent claim 10 recites

> adjusting assembly means that provides for the lateral and forward adjustment of the post driver and its carriage and to move the same generally parallel to the ground to properly position the post driver during usage.

In accordance with the sixth paragraph of § 112, these means-plus-function elements "shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof."

Appellants' specification describes the apparatus corresponding to the foregoing means as follows (page 4, line 20, to page 5, line 2):

> An adjusting assembly 13 is mounted to the mount 11. The carriage 3, in turn, is mounted to the adjusting assembly 13. The adjusting assembly is provided with a pair of crank arms 15 and 17 which are provided, as described in the above-noted patent [Patent No. 5,282,511], to move the carriage 3 and ram 5 in a plane generally parallel to the ground to properly position the post driver.

However, as the examiner notes at pages 7 and 8 of the answer, the '511 patent referred to as describing the adjusting

assembly

does not disclose any adjusting means as claimed, let alone any structure corresponding to such a means. Appellants acknowledge such non-disclosure on page 11, lines 8 to 12 of their brief,[2] where they state (emphasis added):

> The prior patent to Burenga and Koberlein, the '511 patent, simply shows the applicants' prior structure for its post driver, and the bearing means for holding it. But, it did not describe an adjusting assembly that can shift both laterally and forwardly the post driver and its carriage generally parallel to the ground, . . .

In In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), the Court held:

> if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

See also In re Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997) ("Failure to describe adequately the necessary structure [corresponding to the claimed means-plus-

[2] References herein to appellants' brief are to the amended brief filed on March 28, 2000.

function]

. . . in the written description means that the drafter has failed to comply with the mandate of § 112 ¶ 2"). Applying the rationale of these cases to the facts of the present case, it is evident that since the '511 patent on which appellants rely in their specification for a description of the structure of the claimed adjusting means does not in fact describe any such structure, appellants have failed to comply with the second paragraph of § 112.

The Rejections Under § 103(a)

When claims are indefinite, it has been held that they should be rejected under § 112, rather than under § 103. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). However, in an effort to avoid piecemeal appellate review, we will in this instance not reverse the § 103(a) rejections on a pro forma basis, but rather will consider them on the merits, construing (for the purpose of this decision only) the above quoted means-plus-function elements of claims 6, 9 and 10 as being so broad as to include any and all apparatus which would perform the recited function. Cf. Ex parte Saceman, 27 USPQ2d 1472, 1474 (BPAI 1993).

It is unnecessary to discuss all the references applied by the examiner; rather, we will concentrate on Shaver, which the examiner cited as evidence that it would have been obvious to provide a lateral and forward adjustment assembly (i.e., the above-quoted means-plus-function element of claims 6, 9 and 10) on the apparatus of Burenga or Horn. Appellants argue to the effect that modification of the Burenga or Horn apparatus in view of Shaver would not result in a device meeting the means-plus-function element of the claims because the apparatus disclosed by Shaver does not allow lateral and forward adjustment of the carriage and post driver "approximately generally parallel to the ground" or "generally parallel to the ground," as claimed, but rather provides angular adjustment.

Shaver discloses apparatus for adjusting the position of a tractor-mounted post driver relative to the ground. Apparatus is carried by a base plate 20 attached to the tractor, such that when crank 38 is turned, the channel 30 which is attached to the driver is tilted rearwardly and forwardly about pin 32, and when crank 44 is turned, channel 30 is tilted laterally about the axis of tube 28 (col. 2,

lines 5 to 37).

The examiner argues, first, that the functional limitation that the adjustment assembly provides positioning "approximately generally parallel to the ground" is given no patentable weight, since it does not distinguish structurally over the prior art (answer, page 8). We do not agree with this argument, because the function of adjusting the positioning of the carriage and post driver "approximately generally parallel to the ground" is part of the function of the claimed means-plus-function, and as such constitutes a limitation which defines a structural element of the claimed combination. See RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984) (reference does not meet claimed means-plus-function element if it does not disclose structure capable of performing the function).

The examiner further contends that the Shaver apparatus would position the carriage and driver "approximately generally parallel to the ground" in that the tilting movement of Shaver would move the carriage and driver parallel to the ground if the ground were uneven or sloped (answer, pages 8 to

9). This argument is not persuasive since it is evident, reading the claims in the light of appellants' disclosure, that "parallel to the ground" is used in the claims as meaning "parallel to a horizontal ground plane." The Shaver apparatus does not allow positioning of the carriage and post driver in this manner. Moreover, even if the term "ground" in the claims were interpreted as the actual surface of the ground, the Shaver apparatus would not allow lateral and forward positioning of the carriage and driver "parallel to the ground" even if the ground were uneven or sloped, unless the ground surface were a surface shaped as the combination of a forward arc centered about Shavers's pivot point 32, and a lateral arc centered about pivot point 28, a situation which would seem to be so extremely unlikely to occur in practice as to be virtually nonexistent.

Accordingly, the rejection will not be sustained.

Conclusion

The examiner's decision to reject claims 2 to 4 and 6 to 9 (as construed herein) under § 103(a) is reversed. Claims 2 to 4 and 6 to 9 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant

to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. and Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
JOHN P. MCQUADE Administrative Patent Judge	)

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